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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,331	05/10/2002	Klaus Bartsch	514413-3899	7900

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EXAMINER

LILLING, HERBERT J

ART UNIT PAPER NUMBER

1651

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,331

Applicant(s)

BARTSCH

Examiner

HERBERT J LILLING

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 17-22 is/are objected to.
- 8) ☒ Claim(s) 23-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>Oct 21, 2001 2 pgs.</u> | 6) <input type="checkbox"/> Other: _____ |

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1. Receipt is acknowledged of the election response filed March 31, 2004.
2. Claims 14-26 are now pending in this application.
Claims 1-13 have been cancelled.
3. Applicant has elected with traverse Group I, claims 14-22, drawn to a process for preparing L-PPT of formula I, by the reaction of HMPB, PPO in the presence of aspartate transaminases, classified in class 435, subclass 106.

Claims 23-26 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement dated March 31, 2004.

Applicant has traversed the restriction requirement based on the following:

a. "Applicant respectfully urge that the Restriction Requirement does not establish that searching all the inventions would constitute an undue burden to the Patent Office. " Furthermore, "The MPEP directs the examiner to search and examine an entire application "[f] the search and examination of an entire application can be made without serious burden,... even though it includes claims to distinct or independent inventions".

The search and examination for additional groups that are separate and patentably distinct would be exceptionally burdensome since the additional groups

would require computerized searches. The additional searches require completely different data bank searches that involve the patent office, web sites, Chem. Abs and STN searches for each and every different invention. The cost basis for using the pay data bank bases for the additional searches would increase the fees for the public to obtain patents as well as there will be an enormous increase in the time line in allowing applications due to the lack of compact prosecution.

b. Applicant has argued that the claims are drawn to overlapping searches for Groups I and II. "For example, both Group I and Group II are classified in class 435, and thus overlap and should be examined together." In view of this statement by Applicant, it is apparent that Applicant does not understand the process of examining patent claims. A search and examination requires a mandatory search in the classified area in addition to all reasonable areas that involves a search for the claimed subject matter. Class 435 has been broken down to hundreds of subclasses since at the present time on this date April 21, 2004 there are 138,762 patents classified in Class 435. A detailed search and examination would be extremely burdensome to examine one hundred and thirty eight thousand and seven hundred sixty two patents. There are other requirements for the examination of each and every aspect for each and every claimed invention.

c. Applicant has argued "[T]he MPEP lists two criteria for proper restriction requirement". This application has been filed as a 371, which requires somewhat, differ rules for requiring restrictions that are more difficult for the Examiners.

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In the present case, this Examiner has complied with all of the requirements for the restriction requirements that include the present national stage of this 371 application.

Applicant is entitled to request reconsideration of the present restriction requirement in accordance with the procedure in the MPEP.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-15 are rejected under 35 U.S.C. 102(b/e) as anticipated by Bartsch et al, Reference AO or Bartsch et al U.S. 6,335,186.

The references anticipate the preparation of the L-PPT within the scope of the broad claimed inventions.

5. Claims 17-22 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot be dependent upon another multiple

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claim See MPEP § 608.01(n). Accordingly, these claims have not been further treated on the merits.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

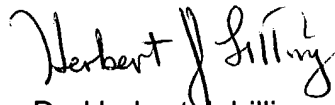
Claims 14-16 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed based on the fact that the enzyme(s) required to practice the instant inventions is not enabling based on the instant application. One of ordinary skilled in the art cannot make and use the specific enzyme without the required microorganism or sufficient information pertaining to the structure of the enzyme per se. In essence this lack of information may be considered to be evidence of concealment of the best mode and only way for one to make and practice the instant inventions.

Claims 14-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention absent the microorganism(s) to obtain the specific enzyme(s) to make and practice the instant inventions. The instant specification does not provide information as to the specific microorganism(s) to obtain the specific enzymes.

7. **No claim is allowed.**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is 571-272-0918** and **Fax Number** is for applications **Before Final** (703) 872-9306 and **After Final** for applications is 703-872-9307 or SPE Michael Wityshyn whose telephone number is 571-272-0926. Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: HJL
(703) 308-2034
Art Unit 1651
April 21, 2004



Dr. Herbert J. Lilling
Primary Examiner
Group 1600 Art Unit 1651